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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,673	11/10/2003	Satoshi Mizutani	20050/0200473-US0	4666
7278	7590	01/25/2007		
DARBY & DARBY P.C. P. O. BOX 5257 NEW YORK, NY 10150-5257			EXAMINER REICHLE, KARIN M	
			ART UNIT	PAPER NUMBER
			3761	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/25/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/705,673

Applicant(s)

MIZUTANI ET AL.

Examiner

Karin M. Reichle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 November 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 4-31 is/are pending in the application.
- 4a) Of the above claim(s) 4-18, 21-27, 29 and 31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 19, 20, 28 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 11-29-06.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11-13-06 has been entered.

### ***Election/Restrictions***

2. Claims 3-18, 21-27, 29 and now new claim 31, are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 7-7-05. The layer configuration species of Figure 43, the pad and inner wrapping configuration species of Figure 6A, the outer wrapping configuration species of Figure 22, and the outer package configuration species of Figure 51 were elected. New claim 31 requires the minisheet piece be formed of a film which is corrugated which is not shown in the elected species of the Figures set forth supra.

### ***Response to Amendment***

3. The substitute specification filed 11-13-06 still does not comply with 37 CFR 1.121, e.g. compare page 29, line 17 of the marked up copy of 11-13-06 and page 33, line 20 of the

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original specification. Note also paragraph 7, section 7 of the 8-6-05 Office Action. The amendments to the abstract still do not comply with 37 CFR 1.121, i.e. the text of the second paragraph of the abstract deleted is not that of the original, i.e. where are the numerals shown in the original shown as deleted. However such have been entered. Therefore the following action is based on the substitute specification and abstract filed 11-13-06, the Figures filed originally and 11-13-06 and the claims filed 11-13-06.

#### ***Specification***

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

For Example:

#### ***Drawings***

5. The drawings were received on 11-13-06. These drawings are approved by the Examiner. However see the following paragraph.

6. The drawings are objected to because in Figure 28, the adhesive, see page 40 last two lines, should still be denoted. The Figures and descriptions thereof throughout the specification should be carefully reviewed and revised, as necessary, to provide a consistent description both pictorially and textually. Applicant is thanked in advance for his/her assistance in placing the specification in consistent form. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended

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replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Description***

7. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: the abstract, last sentence.

8. The disclosure is objected to because of the following informalities: The specification is replete with informalities. For example: 1) The Summary of the Invention section, i.e. a description of the claimed invention, and the invention of the claims is still not commensurate in scope, see MPEP 608.01(d). 2) Is the broken line 15 only provided in the rear face of the

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wrapping container? If so, how is the front face of the wrapping container divided as shown in Figure 7? It should be noted that the front face of the wrapping container is believed to be as shown in Figures 1(D) or 3(B), i.e. how is tape 14 and sealed longitudinal ends on the front end torn? 3) Claim 30 now requires a breaking strength of 0.6-2.5 N/inch. On page 60 of the original specification the breaking strength is not only set forth as such but also as being at least 0.6 N/inch lateral. What are the units of breaking strength? N/inch or N/inch lateral? A consistent description of the units should be set forth. See also the discussion infra. The specification should be carefully reviewed and revised, as necessary, to overcome all the informalities. Applicant is thanked in advance for the cooperation in placing the specification in proper form.

Appropriate correction is required.

### ***Claim Objections***

9. Claims 1, 19-20, 28 and 30 are objected to because of the following informalities: In claim 1, is the last section missing a word or words? See also discussion in paragraph 11 infra. On the second to last line "bad" should be --pad--. On line 8 of claim 1, after "attached to the", --remainder of the-- should be inserted. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

10. Claim 30 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in

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the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As set forth in MPEP 2164.04, the Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. While the analysis and conclusion of a lack of enablement are based on the factors discussed in MPEP 2164.01(a) and the evidence as a whole, it is not necessary to discuss each factor in the written rejection. The language should focus on those factors reasons and evidence that lead the examiner to conclude the specification fails to teach how to make and use the claimed invention without undue experimentation or that the scope of enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims.

First, what is the claimed invention? As set forth in claim 30 the invention is a minisheet of material having a breaking strength of 0.6 to 2.5 N/inch as best understood, see discussion supra in paragraph 8, section 3) supra. Therefore, the claim also defines the invention by the tests or processes used to determine the breaking strength.

In the instant application, no test, standardized or not has been disclosed with regard to measurement of the breaking strength, i.e. no method, no equipment. Nor is there a specific example of such a material. As discussed in paragraph 8, section 3) supra, the situation is exacerbated by the fact that even the units of the measurement are unclear. In other words, the test used to measure the claimed physical characteristic is not described or disclosed, i.e. enabled, and thus, the claim relying on such is not enabled. Experimentation to determine whether a particular material might include the claim limitation would entail, e.g., all known

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possible tests, standardized or not, which yield a measurement having either the units N/inch or N/inch lateral, i.e. undue experimentation.

For these reasons and evidence, the examiner concludes the specification fails to teach how to make and use the claimed invention without undue experimentation or that the scope of enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims.

11. Claims 1, 19-20, 28 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 1, the invention which is claimed in the last three lines is unclear, e.g. is applicant claiming another minisheet on the last line? See paragraph 9 supra and paragraph 12 infra. Also, it is unclear whether Applicant is claiming a sheet with perforations, i.e. separable sections on lines 1-5, or separate sections, i.e. lines 6 et seq. A clear description should be set forth. See paragraph 12 infra again.

### ***Claim Language Interpretation***

12. The claim terminology is interpreted in light of the specific definitions in the paragraph bridging pages 25-26. Any other claim language not specifically defined has been interpreted in view of the usual and common meaning of such, i.e. the dictionary definition. Also, as best understood, the terminology "wrapping body" refers to the combination of the wrapping container and the pad, and the "wrapping container" is the finished product of "wrapping sheet" without the pad. Therefore it is also noted that claims 1, 19-20, 28 and 30 also



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do not require an interlabial pad merely the capability of individually wrapping such and the capability of inserting or removing such. The terminology “mini sheet piece” is interpreted to require a piece which is a sheet of a size smaller than some other structure of the container. With regard to claim 1, as best understood, see paragraph 11 supra, a wrapping sheet with a broken line and finger insertion portions for each separable section wherein each separable section is provided for inserting or removing a pad with a finger inserted into the finger insertion portion thereof do so is required. Additionally the side edges on line 8 of claim 1 are deemed to be those of the sheet. With regard to claim 30, in light of the discussion supra in paragraphs 8 and 10, i.e. no clear specific dimensions of breaking strength or what test used to determine such set forth, a material which does not tear or become damaged during normal use unless desired, i.e. broken along the broken line, i.e. see the original specification at page 60, lines 18-20 and the claims, will be considered to meet this claim.

***Claim Rejections - 35 USC § 102***

13. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

14. Claims 1, 19-20, 28 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Fitz ‘911.

Claim 1: See Claim Language Interpretation section supra and Fitz ‘911 at the Figures, especially Figures 2a-2e and 4-7, and col. 1, lines 42-55, col. 2, line 21-col. 3, line 24, col. 3, line 62-63, col. 4, line 42-col. 5, line 37, the last paragraph of col. 5, the first paragraph of col. 6, col. 6, line 28-col. 8, line 57, e.g. the container is H1-H5, the wrapping sheet is the container H1-H5

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without the feminine hygiene article or tampon and the broken line of perforations is 50 or 51, see the first full paragraph of col. 3, which enables the wrapping sheet to completely separate or divide into two separate sections, e.g. 10 and 20, each having a finger insertion portion, e.g. the space within each section which receives the finger, and the fingers are inserted into each finger insertion portion of each separate section to insert or remove the feminine hygiene article. The minisheet of the separable sections are the respective portions on either side of the broken line of one of the two planar portions of film disclosed at col. 5, lines 62-col. 6, line 7 which portions are attached at their side edges to the other of the two planar portions of film. The claims further require the container having the capability for individually wrapping an interlabial pad and the sections and finger insertion portions enabling insertion and removal of such a pad. However, it is the Examiner's first position that the tampon as disclosed by Fitz '911 is an "interlabial" pad in that it is inserted between the labia and thereby, the '911 reference explicitly teaches such capabilities. In any case, i.e. the Examiner's second position, '911 teaches all the claimed structure and the capability of using such structure similarly to that claimed for a feminine hygiene absorbent article of similar size and for use in a similar environment. Therefore, there is sufficient factual evidence for one to conclude that the capabilities of such claimed structure would also be inherent in the same structure of '911, see MPEP 2112.01.

Claim 19: See Figure 4, elements 70 and 71 and col. 4, line 52-col. 5, line 5, i.e. the container includes a laminate material having a fiber sheet 70, 71 on an inner face and a plastic film sheet on an outer face.

Claim 20: See, e.g., claim 25 of '911.

Claim 28: See discussion of claim 1 supra.

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Claim 30: See Claim Language Interpretation section supra and, e.g., col. 2, lines 35-46, the paragraph bridging cols. 2-3, col. 5, first full paragraph and col. 5, lines 52-55 of '911, i.e. a material which does not torn or damaged during normal use unless desired, i.e. broken along the broken line. Therefore, the '911 reference is deemed to include a material as claimed as best understood.

### ***Response to Arguments***

15. Applicant's remarks with regard to matters of form have been considered but are either deemed moot in that they have not been reraised or deemed not persuasive for the reasons discussed supra. The remarks with regard to the prior art have been considered but are deemed not persuasive in light of the discussion in the prior art rejection supra.


### ***Conclusion***

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (571) 272-4936. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Karin M. Reichle  
Primary Examiner  
Art Unit 3761

KMR  
January 21, 2007